

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Srikanth Natarjan, et al.

Confirmation No.: 9389

Application No.: 09/838,205

Examiner: Houssain, Tanim M

Filing Date: 04/20/2001

Group Art Unit: 2145

Title: Method and System for Identifying Event Sources in Duplicate IP Networks

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 05/14/2008.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Date of Transmission: 06/05/2008

Respectfully submitted,
Srikanth Natarjan, et al.

By: Jed W. Caven
/Jed Caven Reg. No. 40,551/
Attorney/Agent for Applicant(s)
Reg No. : 40,551
Date : 06/05/2008
Telephone : 720.841.9544

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	
)	
Srikanth Natarjan, et al.)	Group Art Unit: 2145
)	
Serial No.: 09/838,205)	Examiner: Houssain, Tanim M.
)	
Filing Date: 04/20/2001)	Confirmation No.: 9389
)	
For: Method and System for Identifying Event Sources in Duplicate IP Networks		

REPLY BRIEF

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated May 14, 2008.

SUMMARY

The issue on appeal is whether claims 1-3 and 5-7 are properly rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,425,008 to Lecheler, et al. (“Lecheler”) in view of U.S. Patent No. 6,978,265 to Schumacher (hereinafter “Schumacher”).

Appellant contends the following:

1. U.S. Patent No. 6,978,265 to Schumacher was filed January 15, 2002, which is after the filing date of this application. Therefore, Schumacher itself is not available as a prior art reference. (See 35 U.S.C. §102(e)).
2. Schumacher claims a right of priority to U.S. Provisional Patent Application No. 60/262,134, filed January 16, 2001 (hereinafter “Schumacher Provisional”).
3. In order to apply Schumacher as a prior art reference against this application, the Examiner bears the burden to establish that Schumacher is properly entitled to the priority date of the provisional application. (See MPEP 706.02(f)(1)).
4. The Examiner has failed to provide evidence to support the assertion that Schumacher is entitled to the January 16, 2001 priority date of the Schumacher Provisional.
5. Schumacher should not be entitled to the January 16, 2001 priority date of the Schumacher Provisional.
6. Even if Schumacher were available as a prior art reference, Schumacher can be cited only for teachings which are properly supported in the Schumacher Provisional. (See MPEP 706.02(f)(1) and MPEP 2136.03.III).
7. Lecheler, alone or in combination with Schumacher, cannot render obvious the pending claims.

ARGUMENT

1. Schumacher Itself is Not Available as a Prior Art Reference

U.S. Patent No. 6,978,265 to Schumacher was filed January 15, 2002, which is after the filing date of this application. Therefore, Schumacher itself is not available as a prior art reference. (See 35 U.S.C. §102(e)).

2. The Examiner has Failed to Establish Evidence to Support the Assertion that Schumacher is entitled to the January 16, 2001 Priority Date of the Schumacher Provisional

Schumacher claims a right of priority to U.S. Provisional Patent Application No. 60/262,134, filed January 16, 2001 (hereinafter “Schumacher Provisional”). In order to apply Schumacher as a prior art reference against this application, the Examiner bears the burden to establish that Schumacher is properly entitled to the priority date of the provisional application. (See MPEP 706.02(f)(1)). To date, the Examiner has failed to provide evidence to support the assertion that Schumacher is entitled to the January 16, 2001 priority date of the Schumacher Provisional.

Schumacher was first cited in the non-final Office Action mailed June 5, 2007. The Action appeared simply to presume that Schumacher is entitled to the January 16, 2001 priority date of the Schumacher Provisional. The final Action mailed November 21, 2007 appears to simply reiterate the assertions set forth in the non-final Action mailed June 5, 2007. Neither Office Action bothered even to make the assertion that Schumacher is entitled to the January 16, 2001 priority date of the Schumacher Provisional, much less to set forth any evidence whatsoever to support the assertion.

The Advisory Action mailed December 21, 2007 made the assertion that the Schumacher Provisional “fully teaches the claimed limitations” of Schumacher, but again failed to provide any evidence whatsoever to support the assertion.

The Examiner’s Answer mailed May 14, 2008 attempts to address this deficiency, by providing the following explanation:

Appellant asserts that the Provisional Application 60/262,134 does not support the claims of Schumacher patent 6,978,265. Examiner respectfully disagrees. The provisional application is an overview of the patented claims.

The claimed concept of a data collection agent is discussed on page 13, the claimed condensing agent is discussed on page 14, and the claimed tree configuration is illustrated on page 14. These features certainly support the claimed limitations of the patent. The provisional specification describes the general aspects and components of the invention system, each allowing for certain functionalities. These aspects and components are described in Schumacher's patent claims. As such, the patent claims are fully supported in the provisional application of Schumacher.

Specifically, with respect to Schumacher's patent's claim 1, the provisional application teaches: collecting original data related to each computer and storing the original data in a respective database (pages 1-2, sections 1-5); generating an index table including index data for each computer wherein the index data is configured to identify at least a portion of the contents of the original data stored in the database, and to facilitate access to the databases over the distributed network ("Implementation Details" on page 3); scanning at least one of the index tables to select databases that match a user query (page 5); and accessing the selected databases to retrieve original data and generate an output therefrom (page 5). As such, the provisional application fully teaches the limitations of claim 1. Similarly, all of the claimed limitations are supported by Schumacher's specification.

It is also noted that Schumacher's priority claim was acknowledged and accepted during prosecution of the eventual Schumacher patent. This further reinforces that the priority claim was appropriate and that the provisional application supports the claimed subject matter.

Further, the Schumacher patent is relied upon to teach that multiple computers may be used to manage a certain domain. Paragraph 2 of the provisional application discloses this limitation as well.

For at least the following reasons, the arguments set forth in the Examiner's Answer are insufficient to meet the Examiner's burden to establish that Schumacher is properly entitled to the priority date of the Schumacher Provisional.

A. The Examiner's Evidence is Insufficient to Establish that Schumacher is Entitled to the Priority Date of the Schumacher Provisional

Foremost, the arguments and evidence cited in the Examiner's Answer are insufficient to establish that Schumacher is properly entitled to the priority date of the Schumacher Provisional. In order for Schumacher to obtain the priority date of the Schumacher Provisional, 35 U.S.C. §119(e) clearly and unequivocally requires that the invention claimed in Schumacher be disclosed in the manner provided by 35 U.S.C. §112. The assertions in the Examiner's Answer that the Schumacher Provisional is an "overview" of the claims which

of the claims which discloses “general aspects and components” of the invention cannot be considered sufficient to meet the burden to establish that the invention claimed in Schumacher be disclosed in the manner provided by 35 U.S.C. §112.

Further, the Examiner’s assertion that the “the provisional application fully teaches the limitations of claim 1” is insufficient because the mapping provided omits elements recited in claim 1. Specifically, the Examiner’s Answer fails to provide any argument or evidence to support that the Schumacher Provisional discloses the following limitations recited in claim 1 of Schumacher:

producing records in the table characterized by a record type selected from the group comprising a database name, a system name, a disk name, a network interface name and a user name; and
producing connection information for each database to facilitate access thereto over the distributed network.

Thus, the Examiner’s Answer fails to establish evidence to support the assertion that even claim 1 in Schumacher is supported by the Schumacher Provisional in the manner required by 35 U.S.C. §112 in order to obtain the priority date of the Schumacher Provisional under 35 U.S.C. §119(e).

Further, there is no evidence of record whatsoever to support the assertion that the remaining claims 2-15 of Schumacher are supported by the Schumacher Provisional in the manner required by 35 U.S.C. §112 in order to obtain the priority date of the Schumacher Provisional under 35 U.S.C. §119(e).

In sum, the evidence of record is insufficient to support the assertion that Schumacher is entitled to the Priority Date of the Schumacher Provisional.

B. The Examiner’s Answer Cannot Simply Rely on the Schumacher’s Priority Claim to Establish that Schumacher is Entitled to the Priority Date of the Schumacher Provisional

To the extent the Examiner’s Answer relies on Schumacher’s priority claim to the Schumacher Provisional to support the assertion, such reliance is misplaced. The provisions of MPEP 706.02(f)(1) clearly require the Examiner to make an independent determination regarding the correct 102(e) date for a prior art reference. This independent determination must be based on the evidentiary record, i.e., factual determinations regarding the compliance

of the provisional application with 35 U.S.C. §112. The Examiner cannot simply rely on the priority claim to establish that Schumacher is entitled to the priority date of the Schumacher Provisional.

3. Schumacher is Not Entitled to the January 16, 2001 Priority Date of the Schumacher Provisional

For at least the following reasons, Schumacher is not entitled to the priority date of the Schumacher Provisional.

A. The Single Claim Filed in the Schumacher Provisional Bears No Relationship to the Subject Matter Claimed in Schumacher

The Schumacher Provisional application was filed with one claim, a single broad independent claim as follows:

A method for managing a plurality of computers from at least one console comprising the steps of:
collecting information associated with the computers;
condensing the collected information in accordance with an index arrangement; and
retrieving data from said condensing information using said index.

By contrast, Schumacher Provisional application includes four independent claims. Independent claim 1 is representative:

1. A method of managing information for a plurality of computers in a distributed network comprising the steps of:

(A) collecting original data related to each computer and storing the original data in a respective database;

(B) generating an index table including index data for each computer wherein the index data is configured (i) to identify at least a portion of the contents of the original data stored in the database, and (ii) to facilitate access to the databases over the distributed network;

wherein said step of generating an index table includes the substeps of:

producing records in the table characterized by a record type selected from the group comprising a database name, a system name, a disk name, a network interface name and a user name; and

producing connection information for each database to facilitate access thereto over the distributed network; and

(C) scanning at least one of the index tables to select databases that match a user query;

(D) accessing the selected databases to retrieve original data and generate an output therefrom.

The remaining independent claims 3, 6, and 14 recite limitations similar to those recited in independent claim 1. A cursory comparison of the single independent claim filed with the Schumacher Provisional with claim 1 of Schumacher reveals that the claim filed in the Schumacher Provisional provides no indication that Schumacher was in possession of the inventions claimed in Schumacher, as required by 35 U.S.C. §112.

B. The Specification of the Schumacher Provisional Fails to Provide Support for Numerous Limitations Claimed in Schumacher

As mentioned above, the Examiner's Answer fails to provide any argument or evidence to support that the Schumacher Provisional discloses the following limitations recited in claim 1 of Schumacher:

producing records in the table characterized by a record type selected from the group comprising a database name, a system name, a disk name, a network interface name and a user name; and

producing connection information for each database to facilitate access thereto over the distributed network.

This is not surprising, as a cursory review of the Schumacher Provisional reveals that the Schumacher Provisional fails to describe these limitations in the manner required by 35 U.S.C. §112 in order to obtain the priority date of the Schumacher Provisional under 35 U.S.C. §119(e).

The remaining independent claims 3, 6, and 14 recite limitations similar to those recited in independent claim 1. Thus, Schumacher Provisional fails to describe these limitations in the manner required by 35 U.S.C. §112 in order to obtain the priority date of the Schumacher Provisional under 35 U.S.C. §119(e). Further, a cursory review of the Schumacher provisional reveals that none of the dependent claims are described in the manner required by 35 U.S.C. §112 in order to obtain the priority date of the Schumacher Provisional under 35 U.S.C. §119(e).

4. Even if Schumacher Were Entitled to the January 16, 2001 Priority Date of the Schumacher Provisional, the Combination of Lecheler and Schumacher Cannot Render Obvious the Pending Claims

Finally, even if Schumacher were entitled to the January 16, 2001 priority date of the Schumacher Provisional, the combination of Lecheler and Schumacher cannot render obvious the pending claims. The outstanding rejections under 35 U.S.C. §103(a) are rendered deficient by substantive errors with respect to the factual findings used to reject the claims. In particular, the Examiner's Answer concedes that Lecheler fails to disclose an arrangement in which a single domain comprises multiple collection and management computers, as recited in the pending claims. To compensate for this deficiency, the Examiner's Answer asserts that Schumacher teaches the implementation of multiple management and collection computers for a single domain, and cites Fig. 1, column 3, line 56-column 4, line 12 of Schumacher. There are no citations to the Schumacher provisional.

Even if Schumacher were available as a prior art reference, Schumacher can be cited only for teachings which are properly supported in the Schumacher Provisional. (See MPEP 706.02(f)(1) and MPEP 2136.03.III). There is no evidence of record whatsoever to support the assertion that the Schumacher Provisional teaches the implementation of multiple management and collection computers for a single domain. Thus, the rejection of claims 1-3 and 5-7 is improper and should be withdrawn.

Further, a cursory review of the Schumacher Provisional reveals that the Schumacher Provisional neither discloses nor even suggests the implementation of multiple management and collection computers for a single domain. Thus, Lecheler, alone or in combination with Schumacher, cannot render obvious the pending claims.

CONCLUSION

The Examiner has failed to establish evidence to support the argument that Schumacher is available as prior art against this application. Further, the Examiner has failed to establish evidence that the Schumacher Provisional properly supports the subject matter for which Schumacher was cited. Accordingly, the outstanding rejections under 35 U.S.C. §103 are improper as a matter of law. Appellants urge the Board to reverse the examiner's rejections of the pending claims.

Respectfully submitted,

Jed W. Caven
Caven & Aghevli LLC
Attorney for Applicants

/Jed W. Caven, Reg. No. 40,551/

By:
Jed W. Caven
Registration No. 40,551
(720) 841-9544

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